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Please find below and/or attached an Office communication concerning this application or proceeding.

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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BENJAMIN WITHROW and STEVEN TERRANOVA

Appeal 2008-3919
Application 09/802,634
Technology Center 3600

Oral Hearing Held: March 17, 2009

Before MURRIEL E. CRAWFORD, HURBERT C. LORIN, and DAVID B.
WALKER, Administrative Patent Judges.

ON BEHALF OF THE APPELLANTS:

JOHN R. WITCHER III, ESQUIRE
WITHROW & TERRANOVA, P.L.L.C.
100 REGENCY FOREST DRIVE
SUITE 160
CARY NC 27518

The above-entitled matter came on for hearing on Tuesday, March 17,
2009, commencing at 9:01 a.m., at The U.S. Patent and Trademark Office,
600 Dulany Street, Alexandria, Virginia, before Kevin E. Carr, Notary
Public.

1 JUDGE CRAWFORD: Good morning, Mr. Witcher.

2 MR. WITCHER: Good morning.

3 JUDGE CRAWFORD: You can begin whenever you're ready.

4 MR. WITCHER: Okay.

5 Good morning. May it please the Board, one of the advantages of the
6 claimed invention in this case is that it makes it easier to shop online no
7 matter where the user is, and in this economy, that's a good thing because we
8 need all the stimulus packages we can get.

9 What the claimed invention is designed to do is to make it easier for
10 the user to interact with a host computing device, and, in particular, to
11 facilitate computing sessions on that computing device. What the user
12 carries is a portable memory device. It could be a card. It could be any
13 other thing that -- you know, is small. The portable device has computer
14 readable memory on it and it has an interface through which the portable
15 device may communicate with the host during a computing session.

16 Importantly, the memory contains software, which in the specification
17 is referred to as keylets, a lot of times, that automatically executes on the
18 computing device during a computing session. The keylets emulate a file
19 system on the host so that the software automatically executes when the user
20 is using a Web browser or other computing session.

21 The software on the portable device executes on the host and instructs the
22 host to do certain tasks, okay? And that's very important in this case, so that
23 the one example that -- or what the claimed invention says is that the
24 software executes on the host and instructs the host to do several things.
25 It recognizes financial account fields in a browsing session and then

1 automatically fills in the account fields with information from the portable
2 device.

3 So the portable device interacts with the software that executes on the
4 host, and then when the host in a computing session actually pulls the data or
5 financial information from the portable device and fills in the fields on the
6 Web page.

7 Then, one other thing that the claimed invention does is that once the
8 computing session or Web session is terminated, only at the termination the
9 software from the portable device that is executing on the host instructs the
10 host to clean that information from the memory of the computing device
11 such that any sensitive information won't be left on there. This
12 is advantageous because it enables a user, no matter where that user is, no
13 matter what computing device he's on, to be able to have personal
14 information available to him so that, for example, if you're in a mall or in
15 any public library and you're doing online shopping, if you had your key
16 with you, your little portable device with you, it doesn't matter what's on the
17 host. You know, as long as it can execute the software, the software from
18 the portable device will be downloaded, the host will be instructed to
19 recognize and fill in those fields with your data -- so your name, shipping
20 information, your credit card information and that sort of thing.

21 So if you look at Claim 1, and that's obviously in the Appendix to the
22 Appeal Brief or on page 3 of the Appeal Brief, what Claim 1 actually claims
23 is that a body, a memory within the body that contains both software and
24 financial account information, and then an interface associated with the
25 memory that's in the portable device, adapted to facilitate interaction with
26 the host during a computing session. Then the software -- and remember

1 that's from the portable device -- executes on the host and instructs the host
2 to do various things, recognize the financial account fields on a Web page
3 during a browsing session, fill in those financial account fields with the
4 financial account information from the portable device. It will automatically
5 execute in association with the computing session. So once you pull up a
6 Web page and it's like a shopping cart or something like that, that's going to
7 automatically execute the software so that you can get the data from the
8 portable device.

9 Now, the Examiner in this case has put together several references
10 that he claims teach the claimed invention. Even if those references are
11 combined, what they do not teach is that there is both software and financial
12 information on the portable device where that software from the portable
13 device automatically executes on the host and instructs the host to do those
14 things, recognizing and filling of financial account fields. It uses the
15 information from the portable device to do that.

16 The first reference that the Examiner uses is Pitroda. Let me back up
17 one second. The Examiner actually makes alternate rejections here. He uses
18 -- the first rejection he uses Pitroda with Arnold and Turgeon, and some
19 things that he says are well known in the art.

20 The second reference -- or second rejection -- uses Davis in
21 conjunction with Arnold, Turgeon and what's known in the art. So he's
22 basically using Pitroda and Davis to supposedly teach the portable device
23 with the software and the financial information on it, but neither Pitroda nor
24 Davis show both software and the financial data on the portable device
25 where the software from the portable device is actually executed on the host.

1 In particular, if you look at the sections of Pitroda that the Examiner
2 uses, you can see that that's the case. The Examiner cites the columns 10,
3 lines 10 to 40 -- I'm sorry, lines 40 to 50. So that's column 10, lines 40 to 50
4 of Pitroda. I'll just read that to you.

5 It says, "The home PC 24 interfaces with the UET card," which is
6 what the Examiner is calling the portable device, "to perform transactional
7 analysis to either protect, review or summarize for budgeting purposes.
8 Software for interfacing between the home PC and UET card for reading
9 information on the card is available as long as the conventional components
10 are used or can be specifically written. Software enabling the PC to dial
11 directly to the main central computer used by a service institution within the
12 user of the UET doesn't count as readily available."

13 So you can see that there is software discussed in Pitroda, but that
14 software is not on the portable device and then executed on the host. The
15 software that's mentioned there in column 10, as far as I can tell from
16 reading, that reference does not execute on the host. It's actually external to
17 the portable device and does not execute on the host.

18 The Examiner also cites to column 11, lines 58 to 67 of Pitroda. And
19 in particular, that's a discussion of figure 4. What it says there is that figure
20 4 is a diagram of the major software blocks. So there are software blocks on
21 the UET card, but those software blocks as shown in that -- the cited portion
22 there -- include a database, which may include, for example, you know,
23 certain unique numbers assigned to the card for security, a primary credit
24 card company, and personal data and that sort of thing.

25 So with the software blocks on the UET card, which is what the
26 Examiner is saying is the portable device, that only has data. It's not

1 software -- even though it's stored in software, obviously, but it's not
2 software. And in particular, that software is not executing on the host.
3 The Examiner also cites to column 12, lines 33 through 36 of Pitroda, and
4 that says the UET card software also includes modules, routers, displayed
5 routers, utility and command management, clock and calendar, and various
6 authorization and security things. So there's also other software on the card,
7 but that's for running the card.

8 If you look at figure 1 of Pitroda, you can tell this is not an ordinary
9 credit card type thing. Pitroda intends for the UET card to be a self-
10 sufficient running thing. So it actually has a display on it. It actually has an
11 LED, a beeper, a speaker, all those things that you see on figure 1 there. The
12 software that's referred to there in column 12 is software for running the
13 UET card, which is the portable device. That software, once again, is not
14 executing on the host and does not instruct the host to do anything.

15 So I think it can be seen from these portions of Pitroda that Pitroda
16 does not teach software that resides on the portable device that is then
17 downloaded or executed on the host to instruct the host to do the claimed
18 functions.

19 So the Examiner also tries to use Davis as a reference that supposedly
20 teaches the portable device that has the software, but if you look at Davis,
21 and in particular paragraph 36 of Davis, Davis talks about -- it also talks
22 about a smart card. In paragraph 36, it talks about a smart card device that is
23 configured with the functionality of a server to provide for operation and
24 control of multiple applications. The smart card device can be configured
25 through an interface included within an access device. The smart card
26 device can then organize and manage and store information locally on a

1 portable device rather than requiring the functions to be performed on the
2 access device.

3 So once again, Davis shows software that acts on the portable device.
4 In fact, it says right there, those functions don't have to be performed on the
5 access device. So the software referred to there -- or any software that might
6 be on that smart card in Davis -- is not executed on the host to instruct the
7 host to do the claimed functions.

8 The Examiner also cites to paragraph 43 of Davis. If you look at
9 paragraph 43 of Davis, that's talking about data that's composed on the card -
10 - on the smart card -- and how you would manage it. In paragraph 43, there
11 at the bottom of page 4, it says, "The data management component
12 comprises a component configured for management of user data provided
13 from a smart card device." It says that there are software modules for
14 managing that user data, but those management components are not on the
15 host. And once again, the software from the portable device is not executed
16 on the host to instruct the host to do certain things.

17 So the smart card device in Davis may provide data to the host, but
18 that's not software. Data is not software, and it's not software that executes
19 on the host to instruct the host to do the claimed functions.

20 I think the Examiner also points to paragraph 59 of Davis. Once
21 again, I don't see anything in that paragraph that shows software from this
22 own portable device that executes on the host to instruct the host to do
23 certain things.

24 I now turn to the second kind of element, and I'll start talking about
25 what the things are that the host is instructed to do. The host is instructed to

1 recognize the financial account fields on the Web page and fill in those
2 fields with information from the portable device.

3 For this element of the claim, the Examiner uses Arnold. It's a little
4 bit unclear what part of Arnold the Examiner is specifically citing to, but I
5 think the most relevant portions of Arnold are in column 1, lines 47 through
6 61. This kind of gives you an idea of what Arnold generally related to. You
7 have a palm top computer, and when that palm top computer makes a
8 request a roadblock program, which is located at a remote data center, will
9 correlate personal information fields with the frames of a Web page and
10 send the personal information to the palm top computer. Then the palm top
11 computer will automatically populate the frames of a Web clipping,
12 representing a Web page.

13 So a Web clipping isn't exactly the same as a Web page, but what
14 Arnold does disclose is that information -- personal and including maybe
15 even financial account information -- can be sent to a portable device. The
16 palm top computer in Arnold is a portable device. So what you have in
17 Arnold is actually data being sent from a data center to a portable device.
18 That's kind of the opposite of what we're claiming. We're claiming you have
19 a portable device that executes on a host and instructs the host to get
20 portable information when necessary -- I mean, information when necessary
21 from a portable device.

22 Arnold teaches the opposite. The portable device requests the
23 information from the host -- and in fact, I'm not even sure Arnold should be
24 compatible with Davis or Pitroda, because Arnold specifically says the
25 reason he does that is because of the personal and confidential information,
26 it may be dangerous to store it on a portable device. So that's why he

1 actually gets -- he keeps his personal information stored in a host, or actually
2 it's a remote data center.

3 So based on that, I would submit that Arnold does not even teach the
4 element for which it is cited because it does not teach financial information
5 being stored on a portable device and then being sent to the host when the
6 host needs it. Also, I'll just back up and say I don't think Arnold shows any
7 software on a portable device that would instruct -- that would execute on a
8 host and instruct the host to do the claimed functions.

9 The next element of the claim is that the software instructs the host to
10 automatically execute in association with the computing session. Now, the
11 Examiner here says that auto run stuff is known. I mean, that's been known
12 for a long time, and we don't dispute that. What we do dispute is the claim
13 actually says that the software is automatically executed in association with
14 the computing session. We also would submit that because Pitroda and
15 Davis both have smart cards that really only hold data, and they don't hold
16 software which is downloaded on the host, there's really not reason for an
17 auto run feature, at least not an auto run feature that's going to take software
18 off of the portable device and execute it on the host.

19 The final element of the claim is that in association with the
20 termination of the computing session, the host is instructed by the software
21 that's executed from the portable device to remove any records pertaining to
22 the computing session. The key here is that it's done in association with the
23 termination of the computing sessions, and that's -- and the purpose for this
24 step is, of course, to remove any personal information from a computer that
25 may not be -- you know, it may be a public computer or whatever.

1 The Examiner here cites to Turgeon. Turgeon does discuss removing
2 -- or it does discuss flushing memory. And I'm particularly looking at
3 paragraph 52 of Turgeon. Paragraph 52 of Turgeon talks about you have --
4 you're in a Web session, and what Turgeon has is there's an E-commerce
5 debit card that you put in a CD-ROM drive and it gets certain information
6 off of there, like a PIN number or whatever. In particular, the Examiner
7 cites to the top of page 5 of paragraph 52, "In step 521, after the data is
8 uploaded to the Web host, a memory in the PC, which is the client station, is
9 flushed to erase data used by the active web module."

10 However, if you actually look at the figure that corresponds to
11 paragraph 52, which is figure 5A, 5B and 5C, you'll notice that in step 508
12 the E-commerce debit card is inserted into the drive. In step 510, all the data
13 is removed from the E-commerce debit card. Then, in step 512, the
14 consumer is prompted to remove the E-commerce debit card. Once that card
15 is removed, that's really what triggers the memory to be flushed. In step 521
16 is where the memory is actually flushed. However, that's not the -- that's not
17 the end of the computing session in Turgeon. You'll notice that it goes for
18 another 20-some steps, I think. It goes from 522 all the way to 570 or
19 whatever before the computing session is actually completed.

20 So while Turgeon does flush memory, it does not do it in conjunction
21 with -- it does not remove records associated with a specific computing
22 session in conjunction with the termination of that computing session. So
23 we would respectfully submit that that element is also not shown by the
24 combination.

25 Finally, I guess I would like to just have a couple of minutes to talk
26 about some of the dependent claims which we think are also separately

1 patentable. Obviously, these claims depend on independent claims, and
2 since we don't think the independent claims -- all the elements of those
3 independent claims are shown by the combination, we would say that these
4 dependent claims are patentable for that reason.

5 But if you look at claims 4, 16 and 24, they all have a similar
6 limitation, which is wherein the portable device stores log-on information
7 for a Web site associated with the Web-based transaction. That's the
8 computing session I've been talking about, and the software is then further
9 adapted to instruct the host to determine if log-in information is necessary
10 for the Web site and provide that. Now, of course, that information is
11 provided from the portable device.

12 The Examiner brings in Inala reference to, supposedly, to teach this
13 limitation. Inala really just teaches an auto log-in feature, which we would
14 admit that itself is not new. But importantly, the log-in information in Inala
15 is not stored on a portable device, so that even if Inala was combined with
16 the other references, it still would not teach software on a portable device
17 that executes on the host and instructs the host to do what's specifically
18 claimed in Claims 4, 16 and 24, which is, it actually determines if log-in
19 information is necessary, and then provides it from the portable device.
20 Inala does not teach that because it doesn't teach a portable device with log-
21 in information.

22 Turning to Claims 5, 17 and 25. In a similar fashion, those claims talk
23 about wherein a bookmark is stored on a portable device and the software is
24 further adapted to instruct the host device to make the bookmark accessible
25 by a browser running on the host such that a user may use that bookmark to
26 effectively access the Web site via the browser.

1 Now, Inala discloses what he calls a password call portal and software
2 that manages bookmarks. So he does manage bookmarks, but once again,
3 those bookmarks are not stored on the portable device such that even if Inala
4 was combined with the other references, the combination would not teach
5 software on the portable device that instructs the host to do specifically those
6 steps of making that bookmark accessible for that particular computing
7 session so that the user can access the Web site using the bookmark that's
8 stored on the portable device.

9 So, in summary, I would like to focus once again and emphasize that
10 none of the references show software on a portable device that executes on
11 the host and instructs the host to recognize and fill in financial account fields
12 with financial account information from the portable device. And in
13 particular, looking at Arnold, Arnold does not teach software on the portable
14 device that executes on the host to instruct the host to recognize the fields
15 and fill in the fields with information from the portable device, because
16 Arnold, if anything, teaches the opposite. Arnold teaches that you would
17 send information from a host or a remote computer to the portable device,
18 and then the portable device does it.

19 So the information is not stored on the portable device, so Arnold
20 would not teach that element. And in fact, because Arnold teaches away and
21 says that you shouldn't keep personal and confidential information on a
22 portable device, that would be a reason why you wouldn't even combine
23 Arnold with either Davis or Pitroda.

24 I think I'll stop there and close with that.

25 JUDGE CRAWFORD: Any questions?

26 JUDGE LORIN: I have on one question.

1 MR. WITCHER: Sure.

2 JUDGE LORIN: This appeal is related to an earlier appeal?

3 MR. WITCHER: Yes, sir.

4 JUDGE LORIN: From 2006?

5 MR. WITCHER: Yes, sir.

6 JUDGE LORIN: Were there any comments you wanted to make
7 about the relationship between the two?

8 MR. WITCHER: I think the appeal -- the earlier case focused on
9 whether or not there was financial account information stored on a portable
10 device. The reference -- and it was a different reference, not any of the
11 references cited in this case. I think --

12 JUDGE LORIN: Let me stop you for a second.

13 MR. WITCHER: Sure.

14 JUDGE LORIN: We're dealing with different references --

15 MR. WITCHER: Yes, sir.

16 JUDGE LORIN: -- and the claims; have they been changed since
17 then?

18 MR. WITCHER: I don't --

19 JUDGE LORIN: Do you know offhand?

20 MR. WITCHER: I don't think the claims have been changed since
21 that earlier appeal.

22 JUDGE LORIN: That's all I need to know.

23 MR. WITCHER: I know the focus of that appeal was whether or not
24 there was financial information that was stored on the portable device and
25 then downloaded or sent to the host. In that case, the references that were
26 cited -- which were different references -- talked about that the portable -- or

1 the -- there was a portable device, but it did not store the financial
2 information. The financial information was actually still stored on a server
3 or some remote computer. The portable device could download that stuff
4 from the server, but it wasn't permanently stored on a portable device.

5 I'm pretty sure the claims were the same. I know the part about the
6 software from the portable device being executable on and instructing the
7 host that was definitely the same, although it was not the focus of that
8 appeal.

9 JUDGE LORIN: Thank you.

10 JUDGE CRAWFORD: Any questions? Thank you.

11 MR. WITCHER: Thank you.

12 [The hearing was concluded.]